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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/903,132

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Craig S. Skinner

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26371

7590

09/22/2005

FOLEY & LARDNER

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SUITE 3800

MILWAUKEE, WI 53202-5308

EXAMINER

ELAHEE, MD S

ART UNIT

PAPER NUMBER

2645

DATE MAILED: 09/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/903,132

Applicant(s)

SKINNER ET AL.

Examiner

Md S. Elahee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed on 06/24/05 have been fully considered but they are not persuasive.

Regarding claims 1, 9, 11 and 12, the Applicant argues on page 6, lines 15-21 that “the references do not provide any motivation for combining the teachings together to provide a handheld computer which is configured for e-mail messaging and that establishes a wireless link with a communications network at a time approximating a predetermined time, where the time is selected at random with a predetermined interval to establish the wireless link and further to register the device with a messaging service provider server and then automatically delivering any e-mail messages that may be waiting from the e-mail messaging sender to the handheld computer”. The examiner disagrees with this argument. The applicant didn't claim the citation “automatically delivering any e-mail messages that may be waiting from the e-mail messaging sender to the handheld computer”. Macko suggests using predetermined time (see col.8, lines 27-33). McDonald uses random time because communication unit registers at a random time chosen between random time interval (see col.6, lines 4-9). Since, McDonald provides motivation for using random time interval then one ordinary skill in the art would have combined Macko reference with McDonald reference so that program can select a time at random within a predetermined interval. Macko suggests using electronic mail server (see col.8, lines 31-33), McDonald uses communication unit to register at a random time chosen between random time interval (see col.6, lines 4-9). Pepe discloses that a PDA sends a registration request to PCI server with subscriber ID at a time (see col.16, lines 19-23). Since Pepe provides the motivation

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for using a PDA to send registration request to PCI server then one ordinary skill in the art would have combined Macko reference with McDonald and Pepe references so that communication device of Macko can register with a new site and thereby obtaining new benefit from the site. Thus the rejection of the claims in view of Macko, McDonald and Pepe remain.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later

invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claim 1, 9, 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Macko (U.S. Patent No. 6,052,563) and in view of McDonald et al. (U.S. Patent No. 6,778,829) and further in view of Pepe et al. (U.S. Patent No. 5,742,668).

Regarding claim 1, Macko discloses a communication device 100 [i.e., handheld device] (fig.1).

Macko further discloses inherently a housing.

Macko further discloses a display supported by the housing (fig.1, element 120).

Macko further discloses a central processing unit 160 [i.e., microprocessor] coupled to the display (fig.1, element 116, fig.2, element 160).

Macko further discloses a read only memory [i.e., memory] coupled to the central processing unit [i.e., microprocessor] (fig.2, element 162).

Macko further discloses a transmitter 134 [i.e., radio frequency transceiver] coupled to the central processing unit and configured to establish and maintain a wireless link with a communications network for sending and receiving e-mail messages to and from the communication device (fig.1; col.2, lines 42-50, col.3, lines 32-38, 66, 67, col.4, lines 1-5).

Macko further discloses a control information [i.e., program] stored in the memory and configured to automatically establish the wireless link with the communications network at a time approximating a predetermined time, the program configured to select a time within a predetermined interval to establish the wireless link, the predetermined interval being at least one of adjacent and around the predetermined time (fig.1, 3, 11; col.2, lines 42-50, col.3, lines 10-20,

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32-38, 66, 67, col.4, lines 1-5, col.8, lines 27-33). (Note: communication device is programmed to instruct the server to forward electronic mail to the device at 3 PM (i.e., time approximating a predetermined time), selection of the time is random within a predetermined interval between 3 PM to 12 AM on November 1, therefore, it is clear that the predetermined interval being at least one of adjacent and around the predetermined time)

However, Macko does not specifically teach selecting a random time. McDonald teaches selecting a random time (fig.5; col.6, lines 4-9). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Macko to select a random time as taught by McDonald. The motivation for the modification is to have doing so in order to calculate registration time.

Macko in view of McDonald does not specifically teach “the program also configured to send at the time, a registration message to an e-mail messaging service provider server to identify the handheld computer”. Pepe teaches that the program also configured to send at the time, a registration message to a PCI server [i.e., e-mail messaging service provider server] to identify the PDA [i.e., handheld computer] (fig.12; col.16, lines 13-26). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Macko in view of McDonald to have the program also configured to send at the time, a registration message to an e-mail messaging service provider server to identify the handheld computer as taught by Pepe. The motivation for the modification is to have doing so in order to receive the registration request to check the validation information of the subscriber.

Regarding claim 9 is rejected for the same reasons as discussed above with respect to claim 1. Furthermore, Macko discloses selecting an appointment time [i.e., predetermined time] (fig. 11; col.7, lines 50-58, col.8, lines 9-33).

Macko discloses choosing at random a link time within the interval and attempting to establish a wireless link with the communication network at the link time (fig. 3, 11; col.3, lines 33-39, 66, 67, col.4, lines 1-5, col.7, lines 50-58, col.8, lines 9-33). (Note: since the device is programmed at 3 PM to instruct the server to forward electronic mail to the device after the wireless link being established between the device and the server, the time 3 PM is link time)

Regarding claim 11, Macko discloses that the wireless link is used for providing an e-mail messaging service (col.2, lines 11-14, col.3, lines 33-39, 66, 67, col.4, lines 1-5, col.8, lines 27-33).

Regarding claim 12, Macko discloses the wireless link is a radio frequency (RF) communications link (col.2, lines 11-14).

6. Claims 2-7 and 13-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Macko (U.S. Patent No. 6,052,563) in view of McDonald et al. (U.S. Patent No. 6,778,829) further in view of Pepe et al. (U.S. Patent No. 5,742,668) further in view of Astrom et al. (U.S. Patent No. 6,169,881).

Regarding claims 2-5, Macko in view of McDonald further in view of Pepe fails to teach that the predetermined interval is either a 30 minute interval, a 10 minute interval, a 5 minute interval or a default time. Astrom teaches that the predetermined interval is any time [i.e., either a 30 minute interval, a 10 minute interval, a 5 minute interval or a default time] (col.12, lines 55-67, col.13, lines 1-7, 33-36). Thus, it would have been obvious to one of ordinary skill in the art

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at the time the invention was made to modify Macko in view of McDonald further in view of Pepe to allow the predetermined interval being either a 30 minute interval, a 10 minute interval, a 5 minute interval or a default time as taught by Astrom. The motivation for the modification is to have doing so in order to obtain a plurality of samples that sufficiently represent the location of satellites with respect to the location of the terminal.

Regarding claims 6 and 7, Macko in view of McDonald further in view of Pepe fails to teach that the default time is in the range of 6:00 a.m. to 9:00 a.m. Astrom teaches that the default time is any time (i.e., in the range of 6:00 a.m. to 9:00 a.m) (col.12, lines 55-67, col.13, lines 1-7, 33-36). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Macko in view of McDonald further in view of Pepe to allow the default time being in the range of 6:00 a.m. to 9:00 a.m as taught by Astrom. The motivation for the modification is to have doing so in order to obtain a clear status within the default time interval.

Regarding claim 13-16 are rejected for the same reasons as discussed above with respect to claims 2, 6, 5 and 7 simultaneously.

7. Claims 8 and 10 rejected under 35 U.S.C. 103(a) as being unpatentable over Macko (U.S. Patent No. 6,052,563) and in view of McDonald et al. (U.S. Patent No. 6,778,829) and further in view of Pepe et al. (U.S. Patent No. 5,742,668) and further in view of Owensby (U.S. Patent No. 6,647,257).

Regarding claims 8 and 10, Macko in view of McDonald further in view of Pepe fails to teach that the program is configured to cause registration with a messaging service provider server when the wireless link is established. Owensby teaches that the program is configured to

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cause registration with a messaging service provider server when the wireless link is established (col.4, line 55-col.5, line 1-7). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Macko in view of McDonald further in view of Pepe to allow the program is configured to cause registration with a messaging service provider server when the wireless link is established as taught by Owensby. The motivation for the modification is to have doing so in order to acquire and route communications initiated or received by the subscriber's personal wireless mobile phone.

8. Claims 17 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vook et al. (U.S. Patent No. 5,625,882) in view of McDonald et al. (U.S. Patent No. 6,778,829) further in view of Pepe et al. (U.S. Patent No. 5,742,668).

Regarding claim 17, Vook discloses a wireless communication system (i.e., communications network) (fig.1).

Vook further discloses a user device (i.e., portable electronic device) including an antenna (i.e., transceiver) configured to establish a wireless link to the communications network (fig.1, 2; col.3, lines 14-16).

Vook further discloses that the portable electronic device including a wake mode in which the wireless link is established and messages may be sent and received by the portable electronic device and a sleep mode in which the wireless link is not established and messages may not be sent and received by the portable electronic device, the portable electronic device including a power management technique (i.e., program) to select a time to transition from the sleep mode to the active (i.e., wake) mode during a predetermined time interval (abstract; col.2, lines 1-3, 14-24, 30-49, col.5, line 61-col.6, line 3). (Note: power management technique

determines when a device may transition from a sleep mode to an active mode during a sleep period, therefore, it is clear that the technique selects a time randomly when to transition from the sleep mode to the active during a predetermined time interval)

However, Vook does not specifically teach selecting a random time. McDonald teaches selecting a random time (fig.5; col.6, lines 4-9). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Vook to select a random time as taught by McDonald. The motivation for the modification is to have doing so in order to calculate registration time.

Vook in view of McDonald does not specifically teach “the program is configured to cause registration of the portable electronic device with a messaging server, thereby identifying the portable electronic device to the server”. Pepe teaches that the program is configured to cause registration of the PDA (i.e., portable electronic device) with a PCI server (i.e., messaging server) thereby identifying the PDA to the server (fig.12; col.16, lines 13-26). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Vook in view of McDonald to have the program is configured to cause registration of the portable electronic device with a messaging server, thereby identifying the portable electronic device to the server as taught by Pepe. The motivation for the modification is to have doing so in order to receive the registration request to check the validation information of the subscriber.

Regarding claim 25, Vook discloses that the portable electronic device is a Laptop (i.e., handheld) computer (col.2, lines 33, 34).

9. Claims 18-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vook et al. (U.S. Patent No. 5,625,882) and in view of McDonald et al. (U.S. Patent No. 6,778,829) and

further in view of Pepe et al. (U.S. Patent No. 5,742,668) and further in view of Astrom et al. (U.S. Patent No. 6,169,881).

Regarding claim 18-23 are rejected for the same reasons as discussed above with respect to claims 2-7 simultaneously.

10. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Vook et al. (U.S. Patent No. 5,625,882) in view of McDonald et al. (U.S. Patent No. 6,778,829) further in view of Pepe et al. (U.S. Patent No. 5,742,668) further in view of Owensby (U.S. Patent No. 6,647,257).

Regarding claim 24 is rejected for the same reasons as discussed above with respect to claim 8.

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

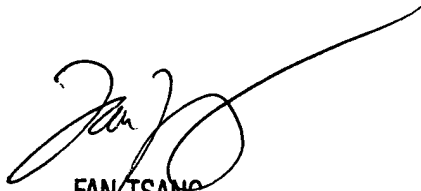
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12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Md S. Elahee whose telephone number is (571) 272-7536. The examiner can normally be reached on Mon to Fri from 8:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (571) 272-7547. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

M. E .
MD SHAFIUL ALAM ELAHEE
September 15, 2005


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